

**REMARKS**

Claims 1-14 are pending in the application.

**Rejection Under 35 U.S.C. § 102 Based Upon Either One of the Siegfried References**

The Examiner has maintained the rejection of claims 1-3, 5-11 and 13-14 under 35 U.S.C. § 102(b) based upon the disclosures of each of United States Patent Nos. 5,833,961 or 5,989,527, each to Siegfried *et al.* ("Siegfried '961 or Siegfried '527") taken individually. The Examiner, relying solely on Siegfried '961, contends that the Siegfried references teach a polyester-based sunscreen composition comprising a polyol polyesters and sunscreen active agents. The Examiner argues that the Siegfried compositions of the Examples are not shown to contain any silicone fluids; therefore, according to the Examiner, they meet the negative limitation of claim 1 is met.

The applicant traverses the rejections.

As set forth in its prior response, Siegfried '961 is directed to polyester based sunscreen formulations containing functionalized polyesters and at least two organic active sunscreen ingredients. None of the polyesters disclosed in Siegfried '961 has the specific structure of Formula I as claimed. Siegfried '961 has not identified the disclosed polyesters as having use as a replacement for low viscosity silicone fluids in personal care compositions. Moreover, while the examples of Siegfried '961 do not include a low viscosity silicone fluid, Siegfried '961 does not teach or suggest expressly that low viscosity silicone fluids should be omitted.

The invention as claimed is directed to compositions to replace the lower viscosity silicone fluid in conventional personal care composition or methods of preparing personal care products while retaining the skin feel and consistency attributes of personal care products that contain low viscosity silicone fluids. The claims recite at least one polyol polyester that is the esterification reaction product of a polyol having 3 to 6 carbon atoms and a carboxylic acid having 3 to 6 carbon atoms with a personal care formulation, wherein the finished care product does not contain a lower viscosity silicone fluid. Siegfried does not teach or suggest that a lower

viscosity silicone fluid should be included or avoided in its sunscreen formulations. In fact, no express discussion of replacing or avoiding silicone fluids is provided.

The Examiner is asserting that the absence of any disclosure in the Siegfrieds of avoidance or replacement of silicone fluids means that the negative limitation of the claims is inherently present. It is well settled law that in order to be inherently present, the claim element must necessarily flow from the disclosure. There, the negative limitation does not flow from the teachings of the Siegfrieds as neither provide any insight or commentary with the absence of silicone fluids or use of the instantly claimed material as a replacement for silicone fluids as claimed.

**Rejection Under 35 U.S.C. § 103 (a) Based Upon Either One of the Siegfried References, Modified**

The Examiner has maintained the rejection of claims 4 and 12 under 35 U.S.C. § 103(a) as being unpatentable over either of the Siegfried references. The Examiner applies the Siegfrieds as above. The Applicant traverses the rejection.

As basis for the obviousness rejection, Examiner contends that the Siegfried, while not discussing the polyesters having only those claimed carboxylic acids of Claim 12, the Examiner contends that Siegfried states that polyesters are formed from a reaction of the diol and a diacid which may have further terminal end groups functionalized by reacting with a mono-functional acid having 2 to 40 carbon atoms such as propionic acid, butyric acid, etc. Therefore, the Examiner reasons it would have been obvious to one of ordinary skill in the art at the time of the invention to prepare a polyol polyester containing both a monofunctional carboxylic as well as the diacid and still expect an effective sunscreen composition.

Neither of the Siegfried references as modified teaches or suggests the invention of claims 4 and 12. The Siegfrieds references considered individually do not teach or suggest all elements of the invention, for the reasons discussed above.

Moreover, a person of skill in the art would have had no apparent reason to modify either of the Siegfrieds to arise at the invention as claimed. Second, a person of skill in the art would not have been motivated to modify either of the Siegfrieds to contain the specific carboxylic acids listed in claims 4 and 12, there is no teaching art motivation or other factor that would have caused a person of skill to take the polyol polyesters of Siegfried and modify the end groups to arrive specifically at the carboxylic acids of claims 4 and 12.

In view of the foregoing, it is submitted that the obviousness rejection is overcome.  
Reconsideration and withdrawal of the rejection is requested.

In view of the foregoing, it is submitted that the claims are not anticipated by the  
Siegfried invention. It is requested that the Examiner reconsider and withdraw her rejection.

**CONCLUSION**

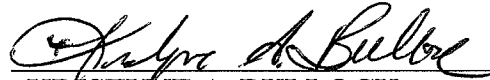
In view of the foregoing, it is submitted that the applicant has fully distinguished the  
claims over the cited prior art. Reconsideration and allowance of the claims at the earliest  
opportunity are respectfully requested.

Respectfully submitted,

**ROCCO BURGO**

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(Date)

By:



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